

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re United States Patent Application of:	)	Docket No.:	4280-107	
	)			
	)			
Applicants:	KNIGHT, David Philip, et al.	)	Conf. No.:	8269
	)			
	)			
Application No.:	10/540,042	)	Art Unit:	Unassigned
	)			
Date Filed:	June 22, 2005	)	Examiner:	Unassigned
	)			
	)			
Title:	APPARATUS AND METHOD FOR STORING PROTEINS	)	Customer No.:	23448
	)			

**EXPRESS MAIL CERTIFICATE**

I hereby certify that I am mailing the attached documents to the Commissioner for Patents on the date specified, in an envelope addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 and Express Mailed under the provisions of 37 CFR 1.10.

Kate Pope

August 22, 2006

Express Mail Label Number

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28 AUG 2006  
*Legal Staff  
International Division*

**RENEWED PETITION UNDER 37 CFR 1.47(a) IN U.S. PATENT APPLICATION  
NO. 10/540,042**

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**ATTN: Office of PCT Legal Administration**

Sir:

This responds to the July 13, 2006 Decision of Petition Under 37 CFR §1.47(a) issued by the U.S. Patent and Trademark Office in the subject application (copy attached).

The July 13, 2006 Decision identifies four items to satisfy the requirements of 37 CFR 1.47(a). (1) a fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of

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the last known address of the missing inventor, (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. According to the Decision, items (1) and (3) have been satisfied, and thus, will not be addressed in this renewed petition.

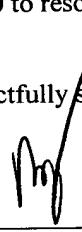
To satisfy items (2) and (4) identified above, the following documents are enclosed herewith:

1. **Declaration by Robert Harrison of Facts and Evidence Relating to Refusal by Larissa Pinnock to Execute a Declaration as a Co-Inventor for U.S. Patent Application No. 10/540,042;**
2. **Declaration and Power of Attorney document, executed by inventor David Philip Knight.**

In view of this renewed Petition and the supporting documentation provided herewith, the Applicants respectfully submit that all applicable requirements under 37 CFR 1.47(a) have been satisfied and that the enclosed the Declaration and Power of Attorney for the above-identified pending application should, therefore, be accepted as fully appropriate. A notice to that effect is respectfully requested.

If any questions remain, incident to the acceptance of this Renewal Petition, the Office is requested to contact the undersigned attorney at (919) 419-9350 to resolve same.

Respectfully submitted,



\_\_\_\_\_  
Steven J. Hultquist  
Reg. No. 28,021  
Attorney for Applicants

INTELLECTUAL PROPERTY/  
TECHNOLOGY LAW  
Phone: (919) 419-9350  
Fax: (919) 419-9354  
Attorney File No.: 4280-107

**Enclosures:**

**Decision on Petition Under 37 CFR 1.47(a) [3 pg.]**  
**Declaration by Robert Harrison & Exhibits 1-4 [12 pg.]**  
**Declaration and Power of Attorney Document [2 pg.]**

The USPTO is hereby authorized to charge any deficiency or credit any overpayment of fees properly payable for this document to Deposit Account No. 08-3284
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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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13 JUL 2006

Steven J. Hultquist  
Intellectual Property/Technology Law  
P.O. Box 14329  
Research Triangle Park, NC 27709

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JUL 17 2006

PTL

In re Application of  
KNIGHT et al.  
U.S. Application No.: 10/540,042  
PCT No.: PCT/EP03/14786  
Int. Filing Date: 23 December 2003  
Priority Date: 23 December 2002  
Attorney Docket No.: 4245-107  
For: APPARATUS AND METHOD FOR  
STORING PROTEINS

: DECISION ON PETITION  
UNDER 37 CFR 1.47(a)

*Deadline to file form  
a/13/06*

This decision is in response to applicants' "Petition for Acceptance of Declaration and Power of Attorney Executed by Assignee on Behalf of Non-Signing Inventor under 37 CFR 1.47(b) . ." filed 25 April 2006, which is being treated as a petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor, Larissa Pinnock. The \$200 petition fee has been submitted.

BACKGROUND

On 23 December 2003, applicants filed international application PCT/EP03/14786 which claimed a priority date of 23 December 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 July 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 23 June 2005.

On 22 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 21 November 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 25 April 2006, applicants filed the present petition.

## DISCUSSION

A filing under 37 CFR 1.47(b) and 35 U.S.C. 118 is permitted only when no inventor is available to make application. Therefore, applicant's petition will be treated under 37 CFR 1.47(a). A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Item (1) and (3) have been satisfied.

Regarding item (2) above, petitioner states that Larissa Pinnock has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Regarding item (2) above, a review of the present petition reveals that petitioner has not satisfied item (2), in that, petitioner has not provided sufficient proof that the inventor refuses to execute the application. Michael Rheinnecker states that "Attorney Robert Harrison contacted Larissa Pinnock by letter dated November 3, 2004.. Larissa

Pinnock responded to such November 3, 2004 letter by correspondence dated December 17, 2004, communicating her refusal to sign such declaration." However, petitioner fails to provide documentary evidence of Larissa Pinnock's refusal. As stated above, when there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. Lastly, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made, i.e. Robert Harrison.

Regarding item (4) above, section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

In this case, applicants filed a declaration executed by the first named inventor and assignee of the above identified application. A declaration executed by the assignee is necessary only when there is no inventor available. Therefore, applicants must submit newly executed declarations executed by the cooperating inventor and containing unsigned signature blocks for the nonsigning inventor. Such a declaration can than be treated as having been executed by the available inventor on their own behalf and on behalf of the nonsigning inventors. Until such declaration is submitted, item (4) is not satisfied.

### CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

**\* No additional petition fee is required.**

Any further correspondence with respect to this matter should be addressed to:  
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298  
Fax: (571) 273-0459

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

23448

**DECLARATION BY ROBERT HARRISON OF FACTS AND EVIDENCE RELATING  
TO REFUSAL BY LARISSA PINNOCK TO EXECUTE A DECLARATION AS A CO-  
INVENTOR FOR U.S. PATENT APPLICATION NO. 10/540,042**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

I, Robert Harrison, hereby declare the following:

1. I am a European and German patent attorney, and on November 3, 2004, I sent to Larissa Pinnock a Declaration of Inventorship for her execution, with a request for such execution, for a United States patent application to be filed based on International Patent Application No. PCT/EP2003/014786.

2. The Declaration of Inventorship tendered to Ms. Pinnock is attached as Exhibit 1 hereof, and my letter of November 3, 2004 accompanying such Declaration of Inventorship is attached as Exhibit 2 hereof.

3. The letter of Exhibit 2 was sent by me, as counsel to Spin'Tech Engineering GmbH and its predecessor in interest Spinox Limited, now called Oxford Biomaterials Ltd, with whom Larissa Pinnock had been employed; during her tenure at such company, Ms. Pinnock had made the invention of U.S. Patent Application No. 10/540,042 with co-inventor David Philip Knight.

4. Attached as Exhibit 3 hereof is a December 17, 2004 letter from Larissa Pinnock, as signed by her, stating that she "will not be signing your application for my patents to be published in the U.S.A." Ms. Pinnock's letter was directed to Jane Polizzi, my then-secretary at Rouse & Co. International (Patents) Ltd.

5. I affirm the statement of facts contained in the Petition filed on April 25, 2006 in U.S. Patent Application No. 10/540,042, as executed on behalf of Spin'Tech Engineering GmbH by Dr. Michael Rheinheimer, a true and exact copy of which is attached as Exhibit 4.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine and/or imprisonment under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of application or any patent issued thereon.

  
\_\_\_\_\_  
Robert Harrison

Date: 7 August 2006

# **EXHIBIT 1**

Sheet No. ....

**Box No. VIII (iv) DECLARATION: INVENTORSHIP** (only for the purposes of the designation of the United States of America)  
 The declaration must conform to the following standardized wording provided for in Section 276; see Notes to Boxes Nos. VII (i) to (v) (in general) and the specific Notes to Box No. VIII (iv). If this Box is not used, this sheet should not be included in the request.

**Declaration of Inventorship (Rules 4.17(iv) and 51&6.1(a)(iv))  
 for the purposes of the designation of the United States of America:**

I hereby declare that I believe I am the original, first and sole (if only one inventor is listed below) or joint (if more than one inventor is listed below) inventor of the subject matter which is claimed and for which a patent is sought.

This declaration is directed to the international application of which it forms a part (if filing declaration with application).

This declaration is directed to international application No. PCT/EP2003/014787 ..... (if furnishing declaration pursuant to Rule 26ter).

I hereby declare that my residence, mailing address, and citizenship are as stated next to my name.

I hereby state that I have reviewed and understand the contents of the above-identified international application, including the claims of said application. I have identified in the request of said application, in compliance with PCT Rule 4.10, any claim to foreign priority, and I have identified below, under the heading "Prior Applications," by application number, country or Member of the World Trade Organization, day, month and year of filing, any application for a patent or inventor's certificate filed in a country other than the United States of America, including any PCT international application designating at least one country other than the United States of America, having a filing date before that of the application on which foreign priority is claimed.

Prior Applications: GB.0229993.1 filed 23 December 2002 .....

I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the PCT international filing date of the continuation-in-part application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name: PINNOCK, Larissa .....

Residence: 23 St David's Road, Newbury, Berkshire, RG14 5PS, UK .....

(city and either US state, if applicable, or country)

Mailing Address: .....

Citizenship: Russian .....

Inventor's Signature: .....

(If not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application. The signature must be that of the inventor, not that of the agent.)

Date: .....

(of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application)

Name: .....

Residence: .....

(city and either US state, if applicable, or country)

Mailing Address: .....

Citizenship: .....

Inventor's Signature: .....

(If not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application. The signature must be that of the inventor, not that of the agent.)

Date: .....

(of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application)

This declaration is continued on the following sheet, "Continuation of Box No. VIII (iv)".

## **EXHIBIT 2**

# rouse patents

Your ref:

Our ref: SPE 00255/WO S4887-00009 and SPI00118/WO S4868-00010

03 November 2004

Larissa Pinnock  
 23 St. David's Road  
 Newbury  
 Berkshire  
 RG14 5PS

**International Patent Application No. PCT/EP2003/014786****Applicant: Spinox Limited****and International Patent Application No. PCT/EP2003/14787****Applicant: Spin'tec Engineering GmbH (formerly Spinox Limited)**

Dear Larissa,

You will remember that during your employment at Spinox you contributed to two patent applications. I am pleased to say that these patent applications have now been published and I enclose a copy for your records. You are, of course, free to mention these applications in a publication list or in your CV. I shall also keep you informed of the progress of the applications and send copies of the granted patents for your reference.

For the patent applications in the United States, we need you to sign a declaration that you have read and understood the applications. You also declare that you know of no other publications which are relevant to the patentability of the two patent applications. I enclose two copies of the form (one for each patent application) that need to be signed and would be grateful if you would sign and date it in the appropriate place (indicated with a post-it note).

Please return the forms to me as soon as possible. I have also enclosed a stamped and addressed envelope for your convenience.

Please do not hesitate to phone or e-mail me if you have any questions.

Yours sincerely



Robert Harrison  
 E-Mail: rharrison@iprights.com  
 Tel: 00 49 89 2421 8208

Enclosures: - Copy of PCT Publication No. WO 2004/057069  
 - Copy of PCT Publication No. WO 2004/057068  
 - TWO Declarations for PCT Applications (Please sign both)  
 - SAE

#### Chartered Patent Agents • European Patent Attorneys

Rouse & Co. International (Patents) Ltd  
 Reg. No. 3904434 VAT No. GB 722026178

A subsidiary of Rouse & Co. International Ltd

Windanr House	Phone +44 (0)1423 850 000
Cornwall Road	Fax +44 (0)1423 850 800
Harrogate	Email harrogate@iprights.com
HG1 2PW	Web www.iprights.com
United Kingdom	

Offices Harrogate London Munich Oxford

## **EXHIBIT 3**

ROUSE & CO  
WINDSOR HOUSE  
CROMWELL RD  
HARROGATE  
HG1 2PW

23 ST DAVIDS RD  
NEWBURY  
BERKS  
RG14 5PS

17/12/04

Dear Mr Polizzi

Further to your letter of the 3<sup>rd</sup> November, I will not be signing your application for my patents to be published in the U.S.A. David Knight treated me very badly with my redundancy, when he sacked me from Spinox. I will only sign this when this matter has been sorted out, with me getting a financial settlement. If you proceed with out my signature, I will not hesitate to contact my solicitor. Look forward to your reply.

Mrs.L.Pinnock



29 DEC 2004

## **EXHIBIT 4**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**PETITION FOR ACCEPTANCE OF DECLARATION AND POWER OF ATTORNEY  
EXECUTED BY ASSIGNEE ON BEHALF OF NON-SIGNING INVENTOR UNDER 37  
C.F.R. § 1.47(b) IN U.S. PATENT APPLICATION NO. 10/540,042**

**Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

Sir:

Your Petitioner, Spin'Tech Engineering GmbH, as successor-in-interest to Spinox Limited, now called Oxford Biomaterials Ltd (hereafter referred to, jointly and severally, as "STE") hereby petitions for acceptance of the enclosed Declaration and Power of Attorney, executed by assignee on behalf of non-signing co-inventor Larissa Pinnock, under the provisions of 37 CFR §1.47(b), based on the following statement of facts:

1. Larissa Pinnock (the "non-signing inventor") has with co-inventor David Philip Knight made an invention of the subject matter which is described and claimed in U.S. Patent Application No. 10/540,042, filed on June 22, 2005, and for which a patent is sought on the invention entitled, "**APPARATUS AND METHOD FOR STORING PROTEINS.**"
  2. The non-signing inventor has assigned all of her rights, title and interest in the aforementioned U.S. Patent Application No. 10/540,042 to STE. STE is the assignee of Larissa Pinnock's entire right, title and interest in said invention, subject matter,

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and U.S. Patent Application No. 10/540,042 by virtue of a 2002 Employment Agreement between Spinox Ltd and Larissa Pinnock (née Larissa Bucksey), a copy of which is attached herewith in Appendix A, under the provisions of Section 8 ("INTELLECTUAL PROPERTY") thereof.

3. The filing and prosecution of U.S. Patent Application No. 10/540,042 is, and at all times has been, necessary to preserve the rights of assignee STE.
4. Assignee STE through its agent, Attorney Robert Harrison contacted Larissa Pinnock by letter of November 3, 2004, to request her execution of a declaration for a United States patent application to be filed based on International Patent Application No. PCT/EP2003/014786. A copy of such November 3, 2004 letter is attached (Appendix B).
5. Larissa Pinnock responded to such November 3, 2004 letter by correspondence dated December 17, 2004 communicating her refusal to sign such declaration.
6. Attached (Appendix C) is a copy of a resolution of the Board of Directors of STE declaring that STE's agent, Attorney Robert Harrison, has made proper request of Larissa Pinnock for document execution for U.S. Patent Application No. 10/540,042 pursuant to said 2002 Employment Agreement between Spinox Ltd and Larissa Pinnock (née Larissa Bucksey), that such request was refused by Larissa Pinnock, and that Nicholas Skaer, CEO of Oxford Biomaterials Ltd, is authorized by the Board as an officer of Oxford Biomaterials Ltd to execute all documents on behalf of Larissa Pinnock for U.S. Patent Application No. 10/540,042, as may be required to effectuate said Employment Agreement and to perfect STE's ownership of U.S. Patent Application No. 10/540,042, and the invention and subject matter thereof, and as may be necessary to comply with requirements of the United States Patent and Trademark Office applicable to U.S. Patent Application No. 10/540,042, including, without limitation, the execution of Declaration and Power of the Attorney documents, and the execution of Assignment documents, for said U.S. Patent Application.
7. The last known address of Larissa Pinnock is as follows:

23 St. Davids Road  
Newbury  
Berks RG14 5PS  
England

It therefore is requested that the U.S. Patent and Trademark Office accept and grant this "PETITION FOR ACCEPTANCE OF DECLARATION AND POWER OF ATTORNEY EXECUTED BY ASSIGNEE ON BEHALF OF NON-SIGNING INVENTOR UNDER 37 CFR §1.47(b) IN US PATENT APPLICATION NO. 10/540,042."

The petition fee set forth in 37 CFR §1.17(g) in the amount of \$200.00 is enclosed in the form of a credit card authorization form authorizing charging of such amount to the credit card specified therein. Authorization also is given to charge any deficiency and to credit any excess payment to Deposit Account No. 08-3284 of Intellectual Property/Technology Law.

If therefore is requested that the present Petition be granted, as aforesaid.

*M.R.*

Respectfully submitted,

Spin'Tech Engineering GmbH

By:

Name: Dr. Michael Rheinnecker  
Title: CEO

Date: 12. April 2006

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